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DATE: February 17, 2006

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Patent Number
Inventor: Kröger et al.

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FROM: CONNOLLY BOVE LODGE & HUTZ LLP
Roberte M. D. Makowski
PHONE: (302) 658-9141

Attorney Dkt. #: 13111-00002-US

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CONNOLLY BOVE LODGE & HUTZ LLP
1007 North Orange Street, P.O. Box 2207, Wilmington, Delaware 19899
Telephone: (302) 658-9141 **Facsimile:** (302) 658-5614

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Application No.: 10/525674 Attorney Docket No.: 13111-00002-US

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(302) 658-9141
Telephone Number

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Attorney Docket No. 13111-00002-US
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Kröger et al.

Application No.: 10/525674 Confirmation No.: 3744

Filed: February 24, 2005 Art Unit: 1652

For: METHOD FOR ZYMOTIC PRODUCTION OF FINE CHEMICALS CONTAINING SULPHUR (META) Examiner: Meah, M. Y.

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement set forth in the Office Action mailed November 17, 2005, Applicants respectfully traverse and strongly urge reconsideration of the restriction requirement for the following reasons.

The Examiner argues that the methods of Group 1 and II do not share a "special technical feature" which defines a contribution over the prior art, citing U.S. Patent No. 5,840,551 and U.S. Application Publication 2005/0089975. Applicants respectfully disagree that the methods of the present invention do not make a contribution over the references cited by the Examiner. The method of the present invention requires in the first step of the method of claim 1 "coryneform bacteria expressing at least one heterologous nucleotide sequence which codes for a protein with homoserine O-acetyltransferase (metA) activity." U.S. Patent No. 5,840,551 does not teach a method which comprises expression of at least one heterologous nucleotide sequence. Furthermore U.S. Application Publication 2005/0089975 is not properly prior art. It claims the benefit of a U.S. Provisional application filed July 8, 2003 and is only applicable under 35 U.S.C. § 102(e). Yet the present application is a national stage application of International Application PCT/EP2003/009452, which claims the benefit to a German application filed August 26, 2002. Thus the present invention was made before the filing of the U.S. published

application cited by the Examiner. Therefore, U.S. Application Publication 2005/0089975 is inapplicable as a reference to defeat unity of invention.

Furthermore, claim 16 of Group II shares a common technical feature with the claims of Restriction Group I. All require coryneform bacteria expressing a polypeptide encoding a protein with metA activity. Also claim 15 concerns a corresponding technical feature with and L-methionine-producing microorganism.

For these reasons, reconsideration and withdrawal of the restriction is requested.

Alternatively, inclusion of claim 16 into Group I is requested, as it shares the same technical feature as the claims of Group I.

In response to the restriction requirement set forth in the Office Action mailed November 17, 2005, Applicants hereby provisionally elect Group I, claims 1-14 (with traverse).

Restriction To Only Claims Reciting One Protein Sequence Is Inappropriate Where The Claims Are Directed To Methods Of Fermentation

The Examiner has further required the Applicants to select one protein or one nucleotide sequence encoding one amino acid sequence. Applicants strongly disagree with this requirement and request reconsideration and withdrawal.

Applicants' claims are directed to a novel method for fermentative production of at least one sulfur-containing fine chemical requiring expression of at least one heterologous nucleotide sequence which codes for a protein with metA activity. Applicants are not trying to patent the nucleic acid nor the amino acid sequences themselves, but rather a method of using them in the fermentation process of the invention. In Applicants' novel combinations and methods, any protein having the recited function of metA activity can be used. The recited sequences provide for examples of the sequences that can be used in the method.

To limit the present application to claims directed to use of only one protein or nucleic acid encoding the protein would unduly restrict the application to one very narrow invention and require an undue multiplicity of applications to be filed to cover use of other protein. Applicants do not believe that searching the sequences of the proteins is required to examine this application, but only searching for the function is needed. Such a search and examination need not be limited to one specific protein or nucleic acid sequence encoding the protein.

Should the Examiner disagree, Applicants hereby provisionally elect Examiner's first listed pairing: (1) the Protein of SEQ ID NO: 2 or Nucleic acid encoding SEQ ID NO: 2 or the DNA of SEQ ID NO: 1 (with traverse).

Restriction To Only Claims Reciting One Gene Is Inappropriate Where The Genes Are Admittedly Well Known

The Examiner has further required the Applicants to select one gene as recited in claim 12 and one gene as recited in claim 13. Applicants strongly disagree with this requirement and request reconsideration and withdrawal.

The novelty of Applicants' invention is not in the particular genes which encode known enzymes as recited in claims 12 and 13. These particular genes and enzymes are known in the art as disclosed in the specification at pages 18-21. The novelty of claims 12 and 13 rather is in the expression and use of these genes in the novel method of claim 1 in addition to the expression of the heterologous nucleotide sequence of claim 1 which codes for a protein with metA activity. Applicants are not trying to patent the genes or enzymes themselves, but rather a method of using them in the novel method of claim 1.

To limit the present application to claims directed to the use of only one gene or enzyme would unduly restrict the application to one very narrow invention and require an undue multiplicity of applications to be filed to cover use of other genes or enzymes. Applicants do not believe that searching the genes or enzymes is required to examine this application, since these are known and an additional known component to the novel method of claim 1.

Should the Examiner disagree, Applicants hereby provisionally elect the gene lysC of claim 12 (with traverse) and provisionally withdraw claim 13 without prejudice (with traverse).

The International Examiner Found Unity Of Invention Regarding The Sequences And The Genes

Furthermore, the International Examination Authority, as shown in the International Preliminary Examination Report, has not found a lack of unity of invention for the sequences or the genes when applying PCT Rules 13.1 and 13.2.

Additionally, Applicants believe that there is no undue burden on the Examiner to search and examine all groups. As previously noted, this is a 371 application from a PCT application,